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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,332	08/20/2001	Gregory P. Fitzpatrick	BOC9-2001-0007 (242)	5985
40987	7590	02/02/2005		
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER BILGRAMI, ASGHAR H	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,332

Applicant(s)

FITZPATRICK ET AL.

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 36-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/16/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner acknowledges that the applicant has withdrawn claims 31-35.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-30 & 36-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Gudjonsson et al (U.S. 6,564,261 B1).

4. As per claims 1, 18 & 36 Gudjonsson disclosed a method for providing contact list management in a chat session, comprising: providing access to a first contact list by a second chat session participant, said first contact list associated with a first chat session participant and said second chat session participant associated with a second contact list; and providing access to said second contact list by said first chat session participant (col.24, lines 32-43, col.25, lines 6-20 & col.27, lines 36-44).

5. As per claims 2, 17, 20, 37, 52, 55 & 60 Gudjonsson disclosed the method according to claim 1, further comprising the steps of: determining whether said first contact list is modifiable

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by said second chat, session participant; and if said first contact list is modifiable by said second chat session participant, permitting the modification of said first contact list by said second chat session a participant (col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4).

6. As per claims 3 & 38 Gudjonsson disclosed the method according to claim 2, wherein said modification step comprises the step of adding contact information to said first contact list 9col.27, lines 36-44).

7. As per claims 4, 5, 6, 7, 21, 22, 34, 35, 39, 40, 41, 42, 56 & 57 Gudjonsson disclosed the GUI according to claim 31, further comprising a first modifiable status icon which indicates whether said first contact list is accessible and, if said first contact list is accessible, whether said first contact list is modifiable (col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4).

8. As per claims 8 & 43 Gudjonsson disclosed the method according to claim 7, further comprising the steps of: permitting the selection of said displayed icon for said first contact list and said displayed icon for said second contact list by a third chat session participant having a third contact list; comparing said selected first contact list and said selected second contact list to said third contact list; and displaying contacts that are uncommon to said selected first contact list (col.4, lines 31-33, col.29, lines 64-67 & col.30, lines 1-16), said selected second contact list and said third contact list according to results from said comparing step (col.26, lines 40-58).

9. As per claims 9 & 44 Gudjonsson disclosed the method according to claim 8, further comprising the step of: displaying contacts that are common to said first selected contact list,

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said second selected contact list, and said third contact list according to results from said comparing step (col.30, lines 15-29).

10. As per claims 10, 24, 26, 27, 45, 59 & 61, 62 Gudjonsson disclosed the method according to claim 9, further comprising the steps of: permitting any of said first chat session participant, said second chat session participant and said third chat session participant to modify any of said first contact list, said second contact list and said third contact list (col.27, lines 36-44) according to results from said comparing step col.26, lines 37-58); and permitting any of said chat session participants associated with said contact list to reject said modification (col.25, lines 6-20).

11. As per claims 11, 12, 47 & 46 Gudjonsson disclosed the method according to claim 7, wherein if said display icon indicates that said first contact list is not modifiable, further comprising the step of requesting said first chat session participant to allow said second chat session participant to modify said contact list (col.25, lines 21-42).

12. As per claims 13-16, 19, 23, 25, 29, 28, 30, 48-51, 53, 54 & 58 Gudjonsson disclosed a method for providing contact management to parties engaged in a chat communication session, the method comprising: providing access for a first contact list having contact records to a second participant to the communication session, said first contact list associated with a first participant to the communication session, said second participant having an associated second contact list with contact records (col.26, lines 30-50); identifying similar contacts between contact records located in said first contact list and contact records located in said second contact

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list; and adding selected dissimilar contact records located in said first contact list to said second contact list (col.29, lines 64-67 & col.30, lines 1-30).

Conclusion

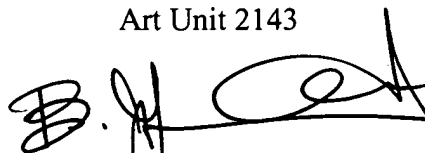
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB

Asghar Bilgrami
Examiner
Art Unit 2143


BUNJOO JAROENCHONWANIT
PRIMARY EXAMINER